

Application No.: 10/650,552
Art Unit 2178

REMARKS

1. Claims 1-51 are pending. In response to the Office Action mailed 03/17/2006, the applicant hereby amends his claims. Claims 3, 6-7, 10-11, 14-17, 20 and 22-51 are canceled. Claims 1-2, 4-5, 8-9, 12-13, 18-19 and 21 are amended. Twelve (12) new claims numbered 52-63 are presented. No new matter is added.

All amendments are fully supported by the originally-filed application including, but not limited to, the drawing together with the of the written description as described in the below eight (8) items labeled "a" through "h":

- a. the paragraph at page 4, lines 2-23;
- b. the description of the drawing views labeled FIGS. 4-6 at page 3, lines 21-30;
- c. the description of the method 100 comprising the originator process 400 depicted in FIG. 4 as 100a, the document distributing apparatus process 500 depicted in FIG. 5 as 100b and the recipient process 600 depicted in FIG. 6 as 100c at page 6, lines 7-10;
- d. the description of the document distributing apparatus steps 505 and 506 from page 9, line 4 to page 10, line 3;
- e. the description of the document distributing apparatus steps 502 and 504 at page 10, lines 4-27;
- f. the description of the recipient step 601 at page 11, lines 13-27;
- g. the description of the optional recipient modifying step 603 at page 12, lines 16-24; and
- h. the description of the recipient step 604 at page 12, lines 1-12.

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2. The remarks below are directed to the remaining claims 1-2, 4-5, 8-9, 12-13, 18-19, 21 and 52-63.

3. Claim 21 was rejected under 35 U.S.C. section 112, second paragraph, as being indefinite. It is believed this rejection is based on the limitation "determining when the document distribution job is complete", which limitation is introduced in claim 18. In response to this rejection, claim 18 has been amended to define "determining when the document distribution job is complete" as being based on "determining when all recipients of the one or more recipients have returned the document to the document distributing apparatus". As a result, this rejection is traversed.

4. Claims 1-2, 4-5, 18-19 and 21 were rejected under section 102 as being anticipated by Richard L. Anglin, Jr. et al., U.S. Patent Number 5,892,591 (hereinafter "Anglin"). In response, these claims have been amended to more clearly and more patentably distinguish the claimed invention over Anglin. As a result, and for the reasons discussed below, these rejections are traversed.

Based on M.P.E.P. section 706.02, "for anticipation under 35 U.S.C. 102, the reference (Anglin) must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present".

In contrast, however, when these claims are compared to Anglin, substantial differences become apparent. This is explained below.

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5. As to the rejection of claim 1 under section 102, this claim is copied below.

Line: Text:

1 A method (100a [400], 100b [500], 100c [600]) to distribute a document (9) to
2 one or more recipients (RECIPIENT 1 - RECIPIENT N), the method comprising:
3 by an originator (1):
4 providing (step 403) a document (9) to an included document distributing
5 apparatus (10), the document comprising a cover sheet (200) including a cover
6 sheet information (201), the cover sheet information including (step 402) a
7 document distribution job information (290);
8 by the document distributing apparatus:
9 receiving (step 501) the document from the originator;
10 scanning (step 503) the document to provide the document distribution job
11 information (290);
12 distributing (step 505) the document based on the document distribution job
13 information (290) to the one or more recipients by means of an included
14 communication network (20); and
15 by at least one recipient of the one or more recipients:
16 receiving (step 601) the document from the document distributing apparatus; and
17 subsequent to receiving the document, returning (step 604) the document to the
18 document distributing apparatus ,

claim 1, as amended, emphasis added to lines 15-18.

As shown in the text above, claim 1 contains the following emphasized
(underlined) limitations in lines 15-18:

Line: Text:

15 by at least one recipient of the one or more recipients:
16 receiving (step 601) the document from the document distributing apparatus; and
17 subsequent to receiving the document, returning (step 604) the document to the
18 document distributing apparatus ,

claim 1, in part, emphasis added to line 15 and 17-18.

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In contrast to claim 1, Anglin contains NO TEACHING OR SUGGESTION of the limitations *"by at least one recipient of the one or more recipients: receiving (step 601) the document from the document distributing apparatus; and subsequent to receiving the document, returning (step 604) the document to the document distributing apparatus)"*, as recited in claim 1, lines 15-18 above, emphasis added.

Since Anglin is DEVOID of any teaching or suggestion of the foregoing limitations, claim 1 is NOT satisfied by Anglin.

In summary, as shown above, claim 1 comprises limitations in lines 15-18 that are NOT satisfied by Anglin. As a result, Anglin does NOT "teach every aspect of the claimed invention" in claim 1, as required by M.P.E.P. section 706.02 to support the rejection of anticipation. Therefore, claim 1 is NOT anticipated by Anglin, and this rejection is traversed.

6. Further to claim 1, now the remaining applied references John E. Braun et al., U.S. Patent Application Publication No. 2004/0061888 A1 ("Braun") and Michael Constantin et al., U.S. Patent Application Publication No. 2003/0002068 A1 ("Constantin") are discussed. As to Braun, this reference is DEVOID of any teaching or suggestion of the limitations recited in claim 1, lines 15-18 above. Further, as to Constantin, likewise, this reference also is DEVOID of any teaching or suggestion of the limitations recited in claim 1, lines 15-18.

7. In summary, as to the reference Anglin, this single (1) reference does NOT anticipate claim 1. Moreover, as to the three (3) references Anglin, Braun and Constantin, whether considered individually or in combination, when the invention of claim 1 is compared with these references, distinct differences become apparent. However, unless these references, by themselves, would have suggested not only these differences but also the entire invention of claim 1, viewed as a whole, to one of ordinary skill in the art at the time the invention was made, then claim 1 is patentable (allowable) over these references. As a result, this rejection is traversed.

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8. Claims 2, 4-5, 8-9, 12-13, 18-19, 21, and 52-56 are dependent on claim 1. As a result, these dependent claims are believed allowable at least on the grounds that they depend on their common parent claim 1 which, as discussed above, is itself allowable.

9. Further to claim 18, this claim also is believed allowable on the additional and supplemental grounds which are discussed below.

As amended and in its present form, claim 18 contains the limitations *"by the document distributing apparatus, determining (step 504) when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when all recipients of the one or more recipients have returned (step 604) the document to the document distributing apparatus"*, claim 18, in part, emphasis added.

In contrast to the underlined limitations in claim 18 above, Anglin contains NO teaching or suggestion of the claimed limitations recited above. Further, both Braun and Constantin likewise are DEVOID of any teaching or suggestion of these limitations.

Thus, when Anglin, Braun and Constantin are compared to claim 18, distinct differences become apparent. However, unless these references, by themselves, would have suggested not only these differences but also the entire invention of claim 18, viewed as a whole, to one of ordinary skill in the art at the time the invention was made, then claim 18 is patentable (allowable) over these references.

In summary, claim 18 is further believed allowable based on the additional and supplemental grounds discussed above.

10. Claims 19, 21 and 54-56 are dependent on claim 18. As a result, these dependent claims also are believed allowable on the additional and supplemental grounds that they depend on their common parent claim 18 which, as discussed above, is itself allowable.

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11. The allowability of the newly-presented claims 57-63 now is discussed.

As to claim 57, this claim is copied below:

Line: Text:

1 A method (100a [400], 100b [500], 100c [600]) to distribute a document (9) to
2 one or more recipients (RECIPIENT 1 - RECIPIENT N) comprising, by a
3 document distributing apparatus (10):
4 receiving (step 501) the document, the document comprising a document
5 distribution job information (290);
6 scanning (step 503) the document to provide the document distribution job
7 information (290);
8 distributing (steps 505) the document based on the document distribution job
9 information (290) to one or more recipients; and
10 subsequent to distributing the document, receiving (step 502) the document as
11 such document is returned (step 604) from at least one recipient of the one or
12 more recipients ,

claim 57, emphasis added.

As shown in the text above, claim 57 contains the following emphasized
(underlined) limitations in lines 10-12:

Line: Text:

10 subsequent to distributing the document, receiving (step 502) the document as
11 such document is returned (step 604) from at least one recipient of the one or
12 more recipients ,

claim 57, in part, emphasis added to lines 10-12.

In contrast to the underlined limitations in claim 57, lines 10-12 above, Anglin contains NO teaching or suggestion of the claimed limitations recited above. Further, both Braun and Constantin are DEVOID of any teaching or suggestion of the limitations recited in claim 57, lines 10-12 above.

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In summary, as to Anglin, Braun and Constantin, whether considered individually or in combination, when the invention of claim 57 is compared with these references, distinct differences become apparent. However, unless these references, by themselves, would have suggested not only these differences but also the entire invention of claim 57, viewed as a whole, to one of ordinary skill in the art at the time the invention was made, then claim 57 is patentable (allowable) over these references.

12. Claims 58-63 are dependent on claim 57. As a result, these dependent claims are believed allowable at least on the grounds that they depend on their common parent claim 57 which, as discussed above, is itself allowable.

13. Further to claim 60, this claim also is believed allowable on the additional and supplemental grounds which are discussed below.

As amended and in its present form, claim 60 contains the limitations *"including determining (step 504) when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when the document has been received (step 502) from all recipients of the one or more recipients"*, claim 60, in part, emphasis added.

In contrast to the underlined limitations in claim 60 above, Anglin contains NO teaching or suggestion of the claimed limitations recited above. Further, both Braun and Constantin likewise are DEVOID of any teaching or suggestion of these limitations.

Thus, when Anglin, Braun and Constantin are compared to claim 60, distinct differences become apparent. However, unless these references, by themselves, would have suggested not only these differences but also the entire invention of claim 60, viewed as a whole, to one of ordinary skill in the art at the time the invention was made, then claim 60 is patentable (allowable) over these references.

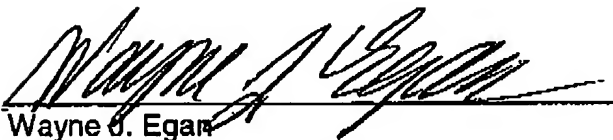
In summary, claim 60 is further believed allowable based on the additional and supplemental grounds discussed above.

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14. Claims 61-63 are dependent on claim 60. As a result, these dependent claims also are believed allowable on the additional and supplemental grounds that they depend on their common parent claim 60 which, as discussed above, is itself allowable.

In summary, it is believed the remaining claims 1-2, 4-5, 8-9, 12-13, 18-19, 21 and 52-63 are allowable and the application is in condition for allowance.

Accordingly, further consideration of this application now is respectfully requested. Please direct questions to the undersigned attorney at the number below.



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